



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,189	10/30/2003	Gary Hochman	0813-016P/JAB	8180

7590 05/18/2006

SCHWEITZER CORNMAN GROSS & BONDELL LLP
292 Madison Avenue
New York, NY 10017

EXAMINER

STOICA, MARIA

ART UNIT	PAPER NUMBER
----------	--------------

3715

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/697,189

Applicant(s)

HOCHMAN, GARY

Examiner

Maria Stoica

Art Unit

3715

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 February 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. In response to the amendment filed on 21 February 2006, the changes to the specification, abstract, and claims 1-3 have been entered, and claims 1-3 and 5-18 are pending.

Drawings

2. The proposed drawings correct the labels written in words but not the number labels. Applicant should submit a similar revision that clarifies the number labels as well. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because it is very difficult to understand the written labels. These labels should be either neatly handwritten or typed such that they can be easily deciphered. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-2, 5-7, 8/7, 11/7, and 15/8/7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 states that the teacher generated review data is placed directly upon the collected gradable material, whereas claim 2, dependent from claim 1, states that the teacher generated review data is placed on a label that is in turn placed on the gradable material. Claim 2 seems to contradict claim 1 since, by placing the teacher review on the label, the teacher review is no longer being placed directly upon the collected material. A clarification is necessary.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 10, 12, 14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bobrow et al. (US Patent No. 6,178,308) in view of Poor (US Patent No. 5,672,060).

Regarding claim 1, Bobrow discloses the steps of:

a) disseminating gradable material to at least one student for the student to enter gradable information therein (elements 201-203 in Figure 2);

b) collecting the gradable material and determining a grade therefore (Figure 10; col. 10, lines 35-37);

c) entering teacher-generated review data for the student from whom the gradable material was collected upon the gradable material in a machine readable format (items 210 and 211 in Figure 2, col. 10, lines 35-40);

d) capturing and storing an image of the gradable material, including the review data, (steps 211 and 205 in Figure 2) in an electronic folder associated with a student identification code thereon (col. 10, lines 42-44); and

e) providing controlled viewing access to the image by specified viewers (step 210 in Figure 2; item 301 in Figure 3; col. 4, lines 52-58).

Bobrow does not expressly disclose that the user to receive access to the image should be authorized. However, Poor teaches a system that captures and stores an image of gradable material, providing controlled viewing access to the image by authorized viewers in the Abstract. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the authorization process taught by Poor in the method disclosed by Bobrow in order to allow for secure access of elements stored in the system.

Bobrow, as modified by Poor, does not expressly teach that the teacher generated review data is placed directly upon the collected gradable material. More specifically, Bobrow discloses that the gradable material is first scanned into the system and printed out in an organized fashion for the teacher to grade (col. 10, lines 30-40). However, it would have been obvious to one of ordinary skill in the art at the time of

invention to eliminate the step of scanning in the student exams in order to organize the content by questions if the result is not desired (see MPEP § 2144.04). The reasoning of eliminating this step would be to save paper.

Regarding claim 10, Bobrow'308 further discloses that the gradable material can be returned to the student after it has been scanned into the system (col. 10, lines 44-50).

Regarding claim 12, Bobrow'308 discloses that the image is a scanned electronic image of the original document (col. 4, lines 7-10).

Regarding claim 14, Bobrow'308 discloses that the grade is placed upon the gradable material in a machine-readable format (col. 8, line 60; col. 10, lines 35-38).

Regarding claim 16, the system of Bobrow'308 further comprises an external storage device to which data can be stored (col. 12, lines 26-27, item 1305 in Figure 13; col. 10, lines 42-44).

5. Claims 2 and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bobrow, as modified by Poor, further in view of Clare (2000). Bobrow, as modified by Poor, teaches a step of locating a label on the gradable material having a pre-determined data capture format for review data to be placed thereon (col. 5 lines 9-14; col. 10, lines 35-40) and placing review data upon the label (col. 5, lines 21-26). Bobrow, as modified by Poor, does not expressly teach that the label is separate from the gradable material or that it should be affixed to the gradable material. However,

Clare teaches a technique by which a teacher may affix a sticker with evaluation information thereon to gradable material submitted by the student (p. 27, #2). It would have been obvious to one of ordinary skill in the art at the time of invention to provide sticker labels for the evaluation of the students in order to allow the teacher to only place a finalized grade on the gradable material and thus prevent the teacher from making mistakes in grading directly on the gradable material.

Regarding claims 5-6, Bobrow discloses that the review data includes a grade and that the review data capture format accommodates the grade (col. 8, line 60; col. 10, lines 35-38).

Regarding claim 7, Bobrow further discloses that the label includes a specified location for the student identification code (col. 5, lines 18-20, see claim 3 rejection).

6. Claims 3, 8/3, 9, 11/3, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bobrow, as modified by Poor, and further in view of Kraft et al. (US Patent No. 4,978,305).

Regarding claims 3, 8/3, and 9, Bobrow, as modified by Poor, does not teach the affixation of a separate label to the gradable material. However, Kraft discloses a grading system comprising the step of locating a label on the gradable material having a specified location (i.e., on each exam) for the affixation of the student identification code (i.e., examinee number), wherein the step of locating a label comprises the affixation of a separate label to the gradable material, wherein the label includes a pre-printed student identification code (col.7, lines 30-35). Therefore, it would have been obvious to

one of ordinary skill in the art at the time of invention to combine the teachings of Kraft of adding the step of affixing a label to the method of Bobrow, as modified by Poor, in order to allow a student to more easily label all work with their student identification code.

Regarding claim 11/3, Bobrow, as modified by Poor, does not teach that the identification code is entered on the gradable material after the gradable material is collected. However, Kraft teaches this aspect (col.7, lines 61-64). It would have been obvious to one of ordinary skill in the art to modify the method disclosed by Bobrow, as modified by Poor, in the way taught by Kraft in order to allow for the affixation of the student identification code after the assignment had been submitted, in case the student had forgotten to attach it.

Regarding claim 15, Bobrow, as modified by Poor, does not teach the step of placing a captured grade in an electronic grade book or database. However, Kraft teaches this aspect (col.10, lines 12-24). It would have been obvious to one of ordinary skill in the art at the time of invention to add the electronic grade book updating step to the method of Bobrow, as modified by Poor, in order to make it easier for the grader to keep track of the grades recorded on the assignments.

7. Claims 8/7, 11/7, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bobrow, as modified by Poor and Clare, further in view of Kraft.

Regarding claim 8/7, Bobrow, as modified by Poor and Clare, does not teach the affixation of a separate label to the gradable material. However, Kraft discloses a

grading system comprising the step of locating a label on the gradable material having a specified location (i.e., on each exam) for the affixation of the student identification code (i.e., examinee number), wherein the step of locating a label comprises the affixation of a separate label to the gradable material, wherein the label includes a pre-printed student identification code (col.7, lines 30-35). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Kraft of adding the step of affixing a label to the method of Bobrow, as modified by Poor and Clare, in order to allow a student to more easily label all work with their student identification code.

Regarding claim 11/7, Bobrow, as modified by Poor and Clare, does not teach that the identification code is entered on the gradable material after the gradable material is collected. However, Kraft teaches this aspect (col.7, lines 61-64). It would have been obvious to one of ordinary skill in the art to modify the method disclosed by Bobrow, as modified by Poor and Clare, in the way taught by Kraft in order to allow for the affixation of the student identification code after the assignment had been submitted, in case the student had forgotten to attach it.

Regarding claim 15, Bobrow, as modified by Poor and Clare, does not teach the step of placing a captured grade in an electronic grade book or database. However, Kraft teaches this aspect (col.10, lines 12-24). It would have been obvious to one of ordinary skill in the art at the time of invention to add the electronic grade book updating step to the method of Bobrow, as modified by Poor and Clare, in order to make it easier for the grader to keep track of the grades recorded on the assignments.

8. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bobrow, as modified by Poor, further in view of Romano et al. (US 5,991,595). Bobrow, as modified by Poor, does not disclose expressly wherein the step of providing viewing access is through the Internet. However, Romano teaches this aspect (col. 6, lines 49-54). Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate providing viewing access through the Internet into the method and system of Bobrow, as modified by Poor, in light of the teaching of Romano, in order to enable a remote communication means.

9. Claims 17 and 18 are rejected under 35.U.S.C. 103(a) as being unpatentable over Bobrow, as modified by Poor, further in view of Housman et al. (US 2003/00224340).

Regarding Claim 17, Bobrow, as modified by Poor, does not disclose expressly wherein the secondary storage media is a CD. However, Housman teaches such on p.1, [0007]. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate wherein the secondary storage media is a CD into the method and system of Bobrow, as modified by Poor, in light of the teaching of Housman, in order to provide a storage media to write files to.

Regarding claim 18, Bobrow, as modified by Housman, does not disclose expressly wherein the transferring step comprises the transfer of a plurality of stored images associated with a particular student identification number (i.e., images if

materials associated with specific students). However, Poor teaches this aspect (col.6: 58-61). Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the aforementioned limitation into the method and system of Bobrow, as modified by Housman, in light of the teaching of Poor, in order to permit efficient retrieval of the images of gradable materials.

Response to Arguments

10. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Regarding the applicant's argument with respect to claim 1 that Bobrow does not expressly disclose placing the teacher marks directly upon the graded material, as clarified by the amendment, the examiner has added a new rejection for this limitation (please see above). Further, although the grading method is computer assisted (i.e., the answer is reformatted, col. 10, lines 44-46), it is noted that the grading is still performed by hand (i.e., in a conventional manner).

Regarding applicant's argument with respect to claim 2, Bobrow is relied upon to teach the application of teacher review data to the original document as explained for claim 1. Furthermore, Bobrow discloses a label area for entering teacher review data. In view of the amendments, the rejection has been revised to include the application of review data onto a label that is subsequently affixed on the gradable material. Please note that newly amended claims 1 and 2 are not considered clear and precise. This issue has been addressed above (#2).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the teacher can use a free form grading or marking system, including colored markings or highlighting) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant further argues that neither Poor nor Kraft teach that a grader apply marks directly upon the original grading document. However, these references have not been relied upon for this feature.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maria Stoica whose telephone number is (571) 272-5564. The examiner can normally be reached on M-F: 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MS


KATHLEEN MOSSER
PRIMARY EXAMINER